

REMARKS

In paragraph 3 of the Action, the Examiner states that [t]his application contains claims 12-21 drawn to an invention nonelected *without* traverse in the reply filed on November 1, 2002.” [Emphasis added.] Then the Examiner cites MPEP 821.01 and states that “[a] complete reply to a final rejection must include cancelation [sic, cancellation] of nonelected claims.” Please note that MPEP 821.01 applies to “Election With Traverse,” *not* without traverse. There is *no* requirement for Applicants to cancel nonelected claims in the response to the final Action when election is *without* traverse. See MPEP 821.02.

In paragraph 4 of the Action, the Examiner states, “[t]he declaration filed on March 8, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the U.S. reference.” The Examiner’s reasoning is that “[t]he evidence presented is drawn to an overcoat [of a polymer resin layer] applied over a deposited [metal] layer, not an anchor coat [of a polymer resin layer] applied *between* a substrate and a deposited metal layer.” [Emphasis added.]

Applicants agree with the Examiner regarding the evidence presented in the declaration. However, the evidence is *fully commensurate* with what is claimed in claim 1. In particular, claim 1 does *not* require an anchor coat of a polymer resin layer must be *between* a substrate and a deposited metal layer as assumed by the Examiner. Though claim 1 includes embodiments in which a polymer resin layer could be between a substrate and a deposited metal layer, claim 1 is *not* limited to such embodiments only.

Claim 1 recites, “A multilayer film comprising a windable, polymeric base material, a polymer resin layer and a metal deposited layer and/or a metal oxide deposited layer provided on the base material” Where does claim 1 recite “an anchor coat applied *between* a substrate and a deposited metal layer” as has been assumed by the Examiner? By the plain reading of claim 1, it recites, “a polymer resin layer and a metal deposited layer and/or a metal oxide deposited layer provided on the base material.” In fact, Example 1 is drawn to an embodiment in

which a polymer resin layer is applied over a deposited metal layer, which is similar to the evidence presented in the declaration.

Claims 1, 3, 5, 7-11 and 22 have been rejected as being obvious over Mokerji in view of Takemura and Pottorff. This rejection is respectfully traversed.

Claims 1 and 22 recite “a *windable*, polymeric base material.” Mokerji is directed to “[a]n article ... coated with a multi-layer coating comprising a polymeric layer deposited on the surface of the article, a chrome/nickel layer deposited on the polymeric layer, and an acrylic layer deposited on the chrome/nickel alloy layer.” See Abstract of Mokerji. The base material of Mokerji, i.e., substrate 18 or polymeric layer 20, is not a windable base material in Mokerji’s articles. Takemura relates to a reflector for circular polarized antenna and has been relied upon by the Examiner for teaching that a reflector could be coated with a weather resistance layer. Takemura too does not fill the gaps in Mokerji. To fill the gaps in both Mokerji and Takemura, the Examiner resorts to Pottorff, stating:

Pottorff teaches that plastic materials are typically made windable so that they can be stored as rolls (col. 1, lines 15+). Thus, it would have been obvious to one of ordinary skill in the art to make the plastic substrate of Mokerji windable. The motivation for doing so would have been to allow for easy storage.

Page 4, lines 12-15, of the Action.

Applicants respectfully submit that the Examiner’s statement that “it would have been obvious to one of ordinary skill in the art to make the plastic substrate of Mokerji windable” is not plausible in light of the fact that Mokerji’s invention is related to chrome plated articles “such as for example, a wheel cover.” Col. 1, lines 52-53, of Mokerji. How does a person of ordinary skill in the art made a “windable” wheel cover? *Nowhere* does Mokerji suggest any chrome plated article that could be “windable” by any stretch of imagination.

The Examiner’s stated motivation that one would “make the plastic substrate of Mokerji windable ... to allow for easy storage” is such a general motivation that it does not respond to the

evidentiary burden which the Examiner must satisfy to make out a *prima facie* case of obviousness. Applicants respectfully submit that the Examiner's motivation is so general that the Examiner could simply have alleged *without* even resorting to Pottorff that:

Plastic materials are typically made windable so that they can be stored as rolls *as evidenced by the plastic food wrap rolls sold in the grocery store*. Thus, it would have been obvious to one of ordinary skill in the art to make the plastic substrate of Mokerji windable. The motivation for doing so would have been to allow for easy storage.

Such a motivation is so broad that it does not answer the central question of why would a person of ordinary skill in the art "make the plastic substrate of Mokerji windable." The answer is apparent: Without applicants' disclosure and claims as a roadmap, *no* person of ordinary skill in this art would have chosen Pottorff. This is classic, impermissible hindsight.

The Examiner's selected motivation is, in fact, so general in the context of the relevant art that it constitutes no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). ***The Examiner's motivation applies to virtually every invention having a plastic material, regardless of what it might be.*** As emphasized by the court in *In re Lee*, 61 USPQ2d at 1433, the Examiner must present specific evidence of motivation, not the generalized evidence relied on in the Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ‘237 patent, col. 4, ll. 34-38.

The reliance in the Action on the fact that “it would have been obvious to one of ordinary skill in the art to make the plastic substrate of Mokerji windable” (see page 4, lines 13-15, of the Action) comes nowhere close to the analysis required by *Lee* and approved in *Thrift*.

Based on *Lee* and *Thrift*, the first question to ask at this point in the analysis is: why, based on Pottorff, would a person of ordinary skill in the art have had any reason to “make the plastic substrate of Mokerji windable?”¹ There is only one reasonable answer: impermissible hindsight reliance on applicants’ disclosure and claims as a roadmap to choose Pottorff and argue that “it would have been obvious to one of ordinary skill in the art to make the plastic substrate

¹ Motivation or suggestion must not merely be to combine references generally; rather, it must be to specifically combine the prior art teachings in the way claimed. *ATD Corp. v. Lydall Inc.*, USPQ2d 1321 (Fed. Cir. 1998) (“Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion . . . to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.”)

of Mokerji windable.”² This failure to present evidence of motivation alone requires that the rejection be withdrawn.

In addition, the second question to ask is: based on Pottorff, would a person of ordinary skill in the art have been able to “make the plastic substrate of Mokerji windable” while *still* maintaining the plastic substrate as component of the chrome plated articles of Mokerji?

Claims 1, 2, 5, 7-11 and 22 have been rejected as being obvious over Fujita in view of Nakanishi and Pottorff. This rejection is respectfully traversed.

Foremost, as explained above, the Rule 131 Declaration is commensurate with the scope of this invention, and Fujita is *not* prior art because the inventor has properly antedated Fujita by the Rule 131 Declaration. The Examiner is requested to consult his Supervisor, if he is still in doubt regarding the Rule 131 Declaration.

Furthermore, the Examiner has relied on Pottorff for motivation “to make the plastic substrate of Fujita windable.” See page 5, line 2 from the bottom, of the Action. This motivation is such a generalized motivation that it suffers from the same defects as explained above in the context of the obviousness rejection of claims 1, 3, 5, 7-11 and 22 as being obvious over Mokerji in view of Takemura and Pottorff.

In light of the above, a Notice of Allowance is respectfully solicited.

² Applicants recognize that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much “hindsight” is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art references themselves as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicants’ position rests on the Examiner’s failure to produce and rely on objective evidence of motivation in the prior art *itself*.

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